

REMARKS

The allowance of claims 1-9 and 11-17 in the Office action of January 22, 2010, is gratefully acknowledged.

In the Office Action of January 22, 2010, claims 18-20 and 23-28 were rejected as being unpatentable over Hurwitz et al., (U.S. Pat. Pub. No. US 2006/0106716 A1) in view of Jones et al. (U.S. Pat. No. 6,318,537 B1) and further in view of Geib et al. (U.S. Pat. No. 5,977,395).

Claim 21 was rejected as being unpatentable over Hurwitz et al., (U.S. Pat. Pub. No. US 2006/0106716 A1) in view of Jones et al. (U.S. Pat. No. 6,318,537 B1) and further in view of Geib et al. (U.S. Pat. No. 5,977,395) and Harris (US Pat. No. 5,067,928).

Request for Allowance of Claim 29

Claim 29 was indicated as rejected on the Office Action summary sheet, but otherwise the action was silent on the status of claim 29, and this claim is deemed to be allowed as depending on claim 11. The Examiner's confirmation of this in the next Office action is respectfully requested.

Rejoinder of Claims 10 and 22

In making the restriction requirement in the Office action of January 5, 2007, at page 2, in the last paragraph the Examiner said "Upon allowance of a generic claim, Applicant will be entitled to consideration of additional species which depend from or otherwise require all of the limitation of an allowable generic claim as provided by 37 C.F.R. 1.141."

Claim 10 is a species claim that depends on allowed claim 1, which is generic. Therefore, claim 10 should be rejoined and allowed on the next action under 37 C.F.R. 1.141 and MPEP 821.04.

Claim 22 is a species claim that depends on claim 18, which is generic. Therefore, claim 22 should be rejoined and allowed on the next action under 37 C.F.R. 1.141 and MPEP 821.04, subject to the allowance of claim 18 as will be discussed below.

STATEMENT REGARDING COMMON OWNERSHIP
UNDER MPEP 706.02 (I) (2)

The undersigned, a duly registered practitioner before the U.S. Patent and Trademark Office, hereby states for the record, that at the time of the invention herein, the base reference Hurwitz et al., (U.S. Pat. Pub. No. US 2006/0106716 A1) cited in the rejection, and the present application were commonly owned by De La Rue plc, a corporate entity organized and existing in the United Kingdom with an office in Basingstoke, England.

Based on the above statement of common ownership the Hurwitz et al. patent publication is removed as a reference in this examination. MPEP 706.02 (I) (2).

BACKGROUND OF THE COMMON OWNERSHIP ISSUE

Hurwitz et al., (U.S. Pat. Pub. No. US 2006/0106716 A1) is cited in the Office action under 35 U.S.C. 103 (a) via 35 U.S.C. 102(e).

The USPTO Manual of Patent Examining Procedure, Sec. 706.02

(I) (1) explains:

"Enacted on November 29, 1999, the American Inventors Protection Act (AIPA) added subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) as disqualified prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." (our emphasis)

The Manual of Patent Examining Procedure, Sec. 706.02 (I)(2) provides:

"The question of whether common ownership exists at the time the claimed invention was made is to be determined on the facts of the particular case in question. "...

"I. DEFINITION OF COMMON OWNERSHIP

"The following examples are provided for illustration only:

Example 1

Parent Company owns 100% of Subsidiaries A and B

- inventions of A and B are commonly owned by the Parent Company."

The Hurwitz et al. '716 published application was owned by De La Rue International Ltd., as shown on the front page of the WIPO publication WO/2004/023255 A2 referred to on the front page of the '716 publication, and in the assignment records of the USPTO. At all times relevant to the date of invention, the present application, was owned by La Rue Cash Systems Inc. These two companies were owned 100

parent by De La Rue plc as shown in the annual reports of De La Rue plc available at <http://www.investis.com/dlar/fininfo/reports/ar 2003> and in the annual report pages, two pages of which are attached as Appendix A. The relevant time is April 10, 2003, the priority date herein, but these facts were also true on the filing date of the present application.

MPEP, Sec. 706.02(I) (2) further provides:

"II. EVIDENCE REQUIRED TO ESTABLISH COMMON OWNERSHIP

"The statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper or in a separately labeled section) in order to ensure that the examiner quickly notices the statement. Applicants may, but are not required to, submit further evidence, such as assignment records, affidavits or declarations by the common owner, or court decisions, *in addition to* the above-mentioned statement concerning common ownership.

"For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

'Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z.'

"This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X." (our emphasis)

After the disqualification of the Hurwitz et al. prior art, the remaining references are the same references cited before the Appeal in this action that led to the allowance of claims 1-9 and 11-17. It is noted that the status of the Hurwitz et al. patent application is that it is abandoned.

Therefore, there is no question of double patenting because, the Hurwitz et al. '716 application will not issue as a U.S. patent.

REMARKS CONCERNING THE PATENTABILITY OF CLAIMS 13-28
OVER THE REMAINING PRIOR ART

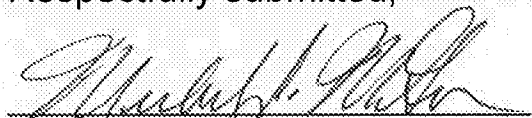
The method claims, as amended, are patentable over the remaining prior art for the reasons already set forth at length in the Appeal Brief at pages 41-53 and in the Reply to the Office Action of October 1, 2009 at pages 11-24 of the Remarks. A minor amendment has been made to claim 18 under 35 U.S.C. 112, second paragraph.

CONCLUSION

In view of the Amendment and Remarks, reconsideration of the application is respectfully requested. After the Amendment, claims 1-9, and 11-17 have been allowed. Claim 29 is also deemed allowed subject to confirmation by the Examiner. Rejoinder and allowance are requested for claim 10 as being dependent on allowed claim 1. Claims 18-21 and 23-29 are still pending and are seen as allowable. Rejoinder for claim 22 is requested, and a Notice of Allowance for claims 1-29 is earnestly solicited.

Respectfully submitted,

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Principal Subsidiaries, Branches and Associated Companies

As at 29 March 2003

The companies and branches listed on these two pages include those which principally affect the profits and assets of the Group. A full list of subsidiary undertakings will be filed with the Company's Annual Return.

Country of Incorporation and operation	Activities	De La Rue Interest in ordinary shares %
EUROPE		
United Kingdom		
De La Rue Holdings plc	Holding and general commercial activities	100 [†]
De La Rue International Limited	Security paper and printing, sale and maintenance of cash handling products and services, identity systems, brand protection and holographics	100
De La Rue Overseas Limited	Holding company	100
De La Rue Investments Limited	Holding company	100
Portals Group Limited	Holding company	100
Portals Property Limited	Property holding company	100
Currency Consulting International Limited	Consultancy	100
Camelot Group plc	Lottery operator	20 [*]
Channel Islands		
The Burnhill Insurance Company Limited	Insurance	100
De La Rue (Guernsey) Limited	General commercial company	100
Belgium		
De La Rue Cash Systems N.V.	Distribution, service and marketing	100
Ireland		
De La Rue Smurfit Limited	Security printing	50
De La Rue Cash Systems Limited	Distribution, service and marketing	100
Italy		
De La Rue Cash Systems s.r.l.	Distribution, service and marketing	100
France		
De La Rue France Holdings SAS	Holding company	100
De La Rue Cash Systems S.A.	Distribution, service and marketing	100
Germany		
IMW Immobilien AG	Property company	95.73
De La Rue Cash Systems GmbH	Distribution, service and marketing	100
De La Rue Systems GmbH	Holding company and distribution and marketing of cash handling products for export	100
Malta		
De La Rue Currency and Security Print Limited	Security printing	100
The Netherlands		
De La Rue BV	Holding company and distribution and marketing of cash handling products	100
Portugal		
Valora-Serviços de Apoio à Emissão Monetária S.A.	Currency printing	25 [*]
De La Rue Systems - Automatizacao, S.A.	Manufacturing, distribution, service and marketing	100
Spain		
De La Rue Systems S.A.	Distribution, service and marketing	100

Country of Incorporation and operation	Activities	De La Rue Interest in ordinary shares %
Sweden		
De La Rue Cash Systems AB	Manufacturer of cash handling equipment	100
Switzerland		
Thomas De La Rue A.G.	Holding company	100
Fidink S.A.	Security ink marketing	33.33*
De La Rue Cash Systems AG	Distribution, service and marketing	100
De La Rue International Limited, Swiss Branch	Design and development centre, principally for cash handling products and solutions	100
NORTH AMERICA		
United States of America		
De La Rue Inc.	Holding company	100
Sequola Voting Systems, Inc.	Manufacture of voting equipment and related software	85
De La Rue Global Services Inc.	Security printing	100
De La Rue Cash Systems Inc.	Design, assembly, distribution, marketing and identity systems	100
De La Rue Systems Limited Partnership	Assembly of cash handling products	100
Currency Systems International Inc.	Assembly and sale of cash handling products	100
Canada		
De La Rue Cash Systems Inc.	Distribution, service and marketing	100
SOUTH AMERICA		
Brazil		
De La Rue Cash Systems Limitada	Distribution, service and marketing	100
Mexico		
De La Rue México, S.A. de C.V.	Distribution, marketing and identity systems	100
AFRICA		
Kenya		
De La Rue Currency & Security Print Limited	Security printing	100
South Africa		
De La Rue South Africa (Proprietary) Limited	Distribution, service and marketing	100
FAR EAST		
Australia		
De La Rue Cash Systems Pty Limited	Distribution, service and marketing	100
Hong Kong		
De La Rue Systems Limited	Distribution, service and marketing	100
Malaysia		
De La Rue (Malaysia) Sdn Bhd	Identity systems	100
Sri Lanka		
De La Rue Lanka Currency and Security Print (Private) Limited	Security printing	60
Thailand		
De La Rue (Thailand) Limited	Distribution, service and marketing	100

* Shares held by De La Rue plc

* Associated company